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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,619	03/10/2004	Zachary W. Lyon	40009-0002	6179
20480	7590	09/20/2005		
STEVEN L. NICHOLS RADER, FISHMAN & GRAVER PLLC 10653 S. RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095			EXAMINER CEGIELNIK, URSZULA M	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,619

Applicant(s)

LYON, ZACHARY W.

Examiner

Urszula M. Cegielnik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 11-20 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/10/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claim 15 is objected to because of the following informalities: Claim 15 appears to recite a typographical error where it recites "ore". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites "a corner of one ore more of said portions is rounded". Claim 13 from which claim 15 depends recites "said flexible extension is split into two or more portions". It is not clear what applicant is intending to claim through this recitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 12, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Munro (US Patent No. 2,874,514).

Munro discloses a vibratory member (23) configured to be vibrated by the spokes of a rotating wheel (col. 2, lines 41-42), and a main body (24) supporting the vibratory member (23) on the vehicle, the main body (24) further comprising an identity plate (21); the identity plate (21) comprises one or more removable panels (26) attached to the main body (24).

Claims 1, 12, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Onori (US Patent No. 6,234,864).

Onori discloses a vibratory member (60) configured to be vibrated by the spokes of a rotating wheel (col. 3, lines 49-51), and a main body (70) supporting the vibratory member (60) on the vehicle (i.e. bicycle), the main body (70) further comprising an identity plate (25,26); the identity plate (25,26) comprises one or more removable panels (25,26) attached to the main body (70).

Claims 1, 4, 6, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US Patent No. 6,589,097).

Smith discloses a vibratory member (3) configured to be vibrated by the spokes of a rotating wheel (col. 3, lines 52-53), and a main body (1A) supporting the vibratory member (3) on the vehicle (i.e. bicycle), the main body (1A) further comprising an identity plate (4A); the vibratory member (3,26,28) snaps into a socket (see Figure 7) on the main body (1A); notches (*the notches proximate portion encompassing reference*

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numeral 2A) disposed around the periphery of the socket for receiving tabs (28) disposed around a periphery of the vibratory member (3,26,28), the notches corresponding to the variety of angles; the vibratory member (3,26,28) is configured to snap into the socket (see Figure 7) at a variety of angles (col. 3, lines 49-53) with respect to the main body (1A) so as to accommodate differently sized bicycles (col. 2, lines 57-59).

Claims 1, 8, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Coleman.

Coleman discloses a vibratory member (52) configured to be vibrated by the spokes of a rotating wheel (paragraph 0007, lines 3-9), and a main body (32) supporting the vibratory member (52) on the vehicle (*i.e. bicycle, wheelchair, or other wheeled devices or vehicles, paragraph 0015 and paragraph 0057, lines 6-9*), the main body (32) further comprising an identity plate (38); the vibratory member (52) comprises a base and a flexible (paragraph 0053, lines 1-3) extension (see Figure 5A, top row, third from left), the flexible extension is split into two or more portions (see Figure 5A, top row, second from left); Figure 5A further shows the flapper having three points comprising apertures by which the flapper may be mounted; the identity plate may include stickers (decals) (paragraph 0056)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro (US Patent 2,874,514) in view of Coleman.

Munro discloses the claimed invention except for the identity plate bearing identification indicia or decorative elements comprising numbers.

Munro discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide indicia in the form of numbers since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of graphics does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. indicia having numbers and the substrate e.g. identity plate which is required for patentability.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro (US Patent No. 2,874,514) in view of Litwin.

Munro discloses the claimed invention except for the identification indicia or decorative elements comprising a sheet of stickers.

Litwin teaches providing stickers or labels that may be affixed to a bicycle (col. 7, lines 14-21).. The stickers include decorative (see Figure 6, for example) as well as identifying indicia (col. 2, lines 1-9).

Litwin does not disclose the stickers or labels being a sheet. The examiner takes Official Notice that stickers or labels are present in a sheet format when printing them using a printer actuated by a computer.

Claims 2, 3, 9, 11, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman.

Coleman discloses the claimed invention except for the identity plate bearing graphics in the form of identification numbers; the splits being tapered, narrowing toward the base and a corner of one or more of the portions being rounded, the fastening arrangement being a zip tie threaded through holes in the vibration element.

With regards to the splits being tapered, narrowing toward the base and a corner of more or more of the portions being rounded, Coleman discloses that the vibration element may be in any geometric or non-geometric shape (paragraph 0056) as well as showing a configuration of a flapper with split configuration in Figure 5A.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the splits as being tapered, narrowing toward the base and the corner of one or more portions as being rounded, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

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its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPG 416.

With respect to the zip tie fastening element, Coleman recites that a variety of other fastening means may be used such as ties, snaps, buckles as well as screws to secure the flapper mount assembly in the enclosure 38 (paragraph 0042, lines 29-32). Coleman further shows apertures in the flapper mount assembly to be used with the above recited fasteners (Figures 2 and 5A).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a zip tie with an associated aperture, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPG 416.

With regards to the identity plate bearing identification numbers, Coleman discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide indicia in the form of numbers since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of

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graphics does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. indicia having numbers and the substrate e.g. identity plate which is required for patentability.

Allowable Subject Matter

Claims 5 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

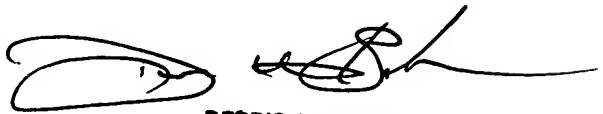
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for both regular and After Final communications.

Urszula M. Cegielnik
Assistant Examiner
Art Unit 3714


DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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